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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,536	05/22/2001	Richard Mcewan	604.30-US1	9172

35856 7590 06/24/2005

SMITH FROHWEIN TEMPEL GREENLEE BLAHA, LLC  
P.O. BOX 88148  
ATLANTA, GA 30356

EXAMINER
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GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/856,536

Applicant(s)

MCEWAN ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6, 8, 10-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan et al, U.S. Patent No. 6,523,037 B1 [Monahan] , and further in view of Shaw et al. U.S. Patent 6,311,211 B1 [Shaw]**

As per Claims 1 and 12-13, Monahan disclose an interactive electronic communication comprising'

a commercial message portion that includes a first branding graphic (Figures 12A-13)

an interface portion that receives a search string designated by the recipient (Col. 5, lines 19-30., Col. 8, lines 30-49),,

a search engine interface (Col. 5, lines 19-30., Col. 8, lines 30-49., and

a searching routine that submits the search string to a search engine via the search engine interface, and returns results to the recipient from within an e-mail client, without using a browser ( Col. 5, lines 27-39, Col. 6, lines 25-31: Col. 7, lines 22-28 and 57-65).

Monahan et al discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a branding graphic portion together with an interface portion that

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receives a search string. However, Monahan et al since shows the placement of a banner ad within an e-mail message (Figure 12B), examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other branding graphics may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30., Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

Monahan discloses the claimed invention except for an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient. However, Monahan does disclose the use of banner ads in the electronic communications (Fig. 12A-C and 13). Shaw teaches that it is known in the art to provide an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient. Col. 10, lines 45-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the banner ad of Monahan with an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient, in order to provide the user with a simple and effective way to reach a providers web site when the information is relevant.

As per Claim 2:

Monahan further disclose wherein the search string is selected from a list of search strings presented to the recipient in the commercial (Figures 12-13).

As per Claim 3:

Monahan further disclose wherein the interface portion contains a space into which the recipient types the search string (Col. 5, lines 19-30', Col. 8, lines 30-49).

As per Claims 4-5:

Monahan further disclose wherein the search engine is a commercial searching facility available through a portal other than the commercial or through a web page of the internet ( Col. 6, lines 22-31 ; Col. 12, lines 5-1 1).

As per Claim 6:

Monahan further disclose wherein the search engine further comprises a graphical hyperlink to an Internet site (Figure 9A and 12B).

As per Claim 8:

Monahan further disclose a results routine that returns a set of results to the recipient through an interface provided by the commercial based upon submitting the search string to the search engine. (Figure 9A, 12A-12B, 13).

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As per Claims 10-11:

Monahan further disclose an audio containing clip included within an email (Col. 9, lines 35-40).

As per Claim 15:

Monahan disclose an interactive electronic commercial sent to a recipient comprising:

providing the commercial with a commercial message portion that includes a first branding graphic (Figures 12A-13)

the recipient opening the attachment and displaying an interface portion that receives a search string designated by the recipient ( Col. 5, lines 19-30., Col. 8, lines 30-49)., and

an e-mail client submitting the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser ( Col. 5, lines 27-39', Col. 6, lines 25-31., Col. 7, lines 22-28 and 57-65).

Monahan discloses the' use of banner ads within an e-mail, however, fails to explicitly disclose a branding graphic portion together with an interface portion that receives a search string. However, Monahan since shows the placement of a banner ad within an e-mail message (Figure 12B), the examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other branding graphics may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described

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above (Col. 5, lines 19-30., Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

Further, Monahan discloses the claimed invention except for an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient. However, Monahan does disclose the use of banner ads in the electronic communications (Fig. 12A-C and 13). Shaw teaches that it is known in the art to provide an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient. Col. 10, lines 45-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the banner ad of Monahan with an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient, in order to provide the user with a simple and effective way to reach a providers web site when the information is relevant.

As per Claim 16:

Monahan disclose a method of sending an interactive electronic commercial sent to a recipient as an e-mail message comprising:

providing an e-mail message to a recipient, the e-mail message including a commercial message portion (Figures 12A-13)

the recipient opening the e-mail message displaying the commercial message portion and an interface portion, the interface portion being operable to receive a recipient designated search string (Col. 5, lines 19-30., Col. 8, lines 30-49)., and

an e-mail client that is operable to submit the recipient designated search string to a search engine, and returning a set of results from submission of the search string to the recipient within the opened e-mail message. (Col. 5, lines 27-39., Col. 6, lines 25-31; Col. 7, lines 22-28 and 57-65).

Monahan discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a commercial message portion together with an interface portion that receives a search string. However, Monahan since shows the placement of a banner ad within an e-mail message (Figure 12B), the examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other commercial messages may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30; Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

Further, Monahan discloses the claimed invention except for an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient. However, Monahan does disclose the use of banner ads in



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the electronic communications (Fig. 12A-C and 13). Shaw teaches that it is known in the art to provide an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient. Col. 10, lines 45-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the banner ad of Monahan with an interactive electronic commercial, and an e-mail message used to convey the interactive electronic commercial to a recipient, in order to provide the user with a simple and effective way to reach a providers web site when the information is relevant.

**Claims 7, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan et al, U.S. Patent No. 6,523,037 B1 [Monahan], in view of Fortenberry et al, U.S. Patent No. 6,101,485 [Fortenberry].**

As per Claims 7, 9 and 14:

Monahan disclose a banner ad within an e-mail message, however, does not specifically disclose an ordering routine through which the recipient orders a product.

Fortenberry discloses a system for electronic solicitations using e-mail and enables a consumer to order products from within the e-mail message (Abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Monahan et al and include the ability to order products from within an e-mail message as taught by Fortenberry. One would have been motivated to

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include an ordering routine to allow the consumer to purchase the products being promoted.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

6/21/2005

Daniel L. Greene  
Examiner  
Art Unit 3621